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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/828,417	03/28/97	MIRASAKI	H P9702-MG

QM32/1109  
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EXAMINER

HOTALING, J

ART UNIT	PAPER NUMBER
3713	7

DATE MAILED: 11/09/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. <b>08/828,417</b>	Applicant(s) <b>Mirasaki et al.</b>
	Examiner <b>J Hotaling II</b>	Group Art Unit <b>3713</b>

Responsive to communication(s) filed on Aug 26, 1999

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 23-38 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 23-38 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

*MICHEL*

**MICHAEL O'NEILL**  
**PRIMARY EXAMINER**

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 25, 27, 28 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 25 recites the limitation "the phrase suspension command" in line 2 of the claim.

There is insufficient antecedent basis for this limitation in the claim. Claim 23 and 25 do not positively recite a "a phrase suspension command".

Claims 27 recites the limitation "said predetermined command" in line 4 of the claim.

There is insufficient antecedent basis for this limitation in the claim. There is a predetermined condition, a plurality of claim data, a predetermined procedure, and a specific command data but there is no previous recitation of a predetermined command.

Claim 28 recites the limitation "the command data" in the first line of the claim and "said specified command data" in line 5 of the claim. There is insufficient antecedent basis for these limitations in the claim. While there is "specific command data there is no specified command data or command data that is previously positively recited in any independent or dependant claim and thus would result in confusion.

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Claim 29 recites the limitation "said first phrase database" in line 2-4 of the claim. There is insufficient antecedent basis for this limitation in the claim. Claim 23 does not positively recite "a first phrase database".

Claim 31 recites the limitation "the command data" at the end of the claim. There is insufficient antecedent basis for these limitations in the claim. While there is "specific command data" there is no command data that is previously positively recited in any independent or dependant claim and thus would result in confusion.

Claims 32, 33, 36, and 37 recite the limitation "said first phrase database". There is insufficient antecedent basis for this limitation in the claim. There is no "a first phrase database" that is previously positively recited in any independent or dependant claim and thus would result in confusion.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 23-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murata et al. '743 (hereinafter Murata '743) in view of Lowe et al '401, Best '073, Best '152 and Cookson et al '950. Murata '743 discloses in columns 1 and 2 a play-by-play announcement corresponding to the proceedings of the game by specifying the adequate terms from a storage portion expressing a word in connection with the game, the storage portion operable to store a plurality of vocal sound groups and a controller operable to produce a new game scene on the monitor in accordance with a game program which are the commands that take the specific sounds saved in a database and output them on a output device. In addition, each data part is assigned a specified address which is stored in the storage portion, or data base, and consists of a data region and a reference region. Column 4 lines 25-70 discloses that the CPU designates an appropriate vocal sound group, which is a command, to be used in the play-by-play announcement in accordance with the development of the game and converts and outputs the data which can also be stored as groups of sounds. Column 5 line 17 through column 6 line 24 disclose the use of alternate phrases based on the play of the game such as when a strike is thrown the program switches or jumps from database to database based on the play of the game based on a predetermined procedure and database replacement condition, player action and/or command data. However, Murata '743 lacks a feature that suspends commentary, provide alternate language commentary, same size databases,

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and wild cards. In an analogous machine Lowe et al. '401, column 2 lines 5-12 discloses that the game may store the video and audio material using laser disk technology, CD-ROM, computer hard drive or other storage means allowing random access retrieval. Column 3 lines 20-35 disclose that the laser video disc storage device provides for storage and retrieval of audio information. Column 5 line 55 through column 6 line 10 discloses that the audio storage and retrieval means can utilize several different formats, and in particular the video laser disc format there may be two audio tracks for one video track and that additional audio tracks can be on other video laser discs, CD's, or on the hard drive that are run in sync with the main program. Column 7 lines 10-31 discloses the timing and control of all video and audio sequences, that the video and audio inserts database stores information on all inserts that are available to the video control logic. Column 11 lines 1-21, teaches that it is known to line up the audio and video, and to mute the play by play commentary and replace it with an audio insert which may be silence or a alternate sound such as music or a commercial. Cookson discloses on column 1 lines 5-15 that the invention relates to the generation of audio signals during play of a software carrier and more particularly to a technique by which multiple dialog languages may be recorded on separate audio tracks. Column 2 lines 25-30 disclose that the invention is not limited to a particular medium or only to the distribution of motion pictures. Column 3 lines 25-30 disclose that it is necessary for the player to control his player for the desired language to be played. Column 12 line 30 through column 13 line 10 disclose that the special software may be game software. Column 37 claim 1 discloses a system for controlling play of the audio tracks of a digital software carrier including a

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dialog language and a switching master to switch to a different audio track. In an analogous process Best '073 discloses the use of alternate phrase databases on figure 11 and column 11 lines 45-50 that may be stored on a disk or in memory, can be used based on the selection of a player which is player action or based on a switching command from the machine which is also a predetermined procedure. Best '152 in column 10 lines 39-70 and column 11 lines 1 and 2 disclose that the audio cue commands are of a fixed length record which are stored into a cue table and that these audio clips where a predetermined procedure for a branch point may abandon some audio cues and select others. The branch point is associated with the progression of the events in the game. The art benefits from the Best patents in that automatic or player selected switching from database to database will result in a games that will have multiple story plots and will not be predictable. One skilled in the art would understand the teachings of Lowe et al. '401 because of the use of speech, commentary, or an alternate sound associated with a game machine. One skilled in the art would understand the teachings of Best and Cookson because database manipulation, storage and retrieval is well known in the art. It would be obvious to combine the above references in order to have a commentary on a video game that is variable and can be of a different language in order to market a product in multiple countries and in order to provide a break in the commentary so that it can be replaced with an alternate sound associated with the game machine or just to mute the commentary. It is an obvious matter of design choice as to how to set up the programing and databases to select the correct phrase based on the play of the game or of the conditions specified by the programmer.

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***Remarks***

3. The objections and 35 U.S.C. 112 rejections of the first office action have been overcome to the satisfaction of the examiner.

***Response to Arguments***

4. Applicant's arguments filed 8/26/99 have been fully considered but they are not persuasive. In response to applicant's argument please see the new grounds of rejection above.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Hotaling II whose telephone number is (703) 305-0780. The examiner can normally be reached Monday- Friday from 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor can be reached at (703) 308-4119.

*—MICHAEL*

John M. Hotaling II  
Patent Examiner  
10/13/99

**MICHAEL O'NEILL  
PRIMARY EXAMINER**

A handwritten signature in black ink, appearing to read "MICHAEL O'NEILL".